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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,946	08/09/2005	Bernard Pau	263432US0XPCT	4965
22850	7590	11/06/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			AEDER, SEAN E	
			ART UNIT	PAPER NUMBER
			1642	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,946

Applicant(s)

PAU ET AL.

Examiner

Sean E. Aeder, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6,7,9 and 13-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4,5,8 and 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

The Election filed 9/11/06 in response to the Office Action of 5/11/06 is acknowledged and has been entered. Applicant elected group I, colorectal cancer, Bax, and TNF with traverse.

The traversal is on the ground(s) that examination of all groups would not impose a serious burden on the examiner. Applicants further point to MPEP 803. Applicant further traverse the election of a cancer species; Applicants state the invention is applicable to cancers other than the elected species. These arguments have been considered but are not found persuasive as such arguments do not apply when restriction is required under 35 USC 121 and 372, as in the instantly filed application. Thus, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. Further, the different species of cancers do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each species represents a separate and distinct cell type with a different morphology and function such that one species could not be interchanged with the other. Further, the species are distinct diseases which differ at least in etiology, pathology, and

mechanisms. For these reasons the restriction requirement is deemed to be proper and is therefore made FINAL.

Claims 1-23 are pending.

Claim 6, 7, 9, and 13-23 are withdrawn from further consideration by the examiner under 37 CFR 1.142(b) as being drawn to a non-elected invention.

Claims 1-5, 8, and 10-12 are currently under consideration.

Claim Objections

Claims 4, 5, 8, and 10-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4, 5, 8, and 10-12 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Independent claim 1 recites a process for in vitro detection of resistance of cancer cells to oxaliplatin treatment characterized in that it involves the measurement of mitochondrial apoptosis of cancer cells that are treated or can or are to be treated with oxaliplatin; however, the claims do not precisely point-out how a measurement of mitochondrial apoptosis of cancer cells that are treated or can or are to be treated with oxaliplatin would determine whether cancer cells are resistant to oxaliplatin treatment. There are missing steps involving correlating specific results, using specific methods, to a determination that a cell is or is not resistant to oxaliplatin treatment. See MPEP § 2172.01.

Claims 1-3 are rejected because claim 1 recites: "...characterized in that it involves the measurement of...". There is insufficient antecedent basis for the word "it" in claim 1.

Claims 2 and 3 are rejected because claim 2 recites: "...characterized in that the cancer is a cancer treated with...". There is insufficient antecedent basis for the term "the cancer" in claim 2.

Claim 3 is rejected for reciting: "...in that it involves...". There is insufficient antecedent basis for the word "it" in claim 3.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the instant case, the claims are inclusive of a genus of mitochondrial apoptosis genes. However, the written description in this case only sets forth Bax as an example of a mitochondrial apoptosis gene. The specification does not disclose any other mitochondrial apoptosis gene as broadly encompassed in the claims.

The specification states that Bax is a mitochondrial apoptosis gene (page 12, in particular). The specification does not disclose any other mitochondrial apoptosis genes. A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or by describing structural features common to that genus that "constitute a substantial portion of the genus." See University of California v. Eli Lilly and Co., 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997): "A description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNA, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural

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features common to the members of the genus, which features constitute a substantial portion of the genus.”

The court has since clarified that this standard applies to compounds other than cDNAs. See University of Rochester v. G.D. Searle & Co., Inc., F.3d, 2004 WL 260813, at *9 (Fed.Cir.Feb. 13, 2004). The instant specification fails to provide sufficient descriptive information, such as definitive structural or functional features that are common to the genus. That is, the specification provides neither a representative number of genes that encompass the genus of mitochondrial apoptosis genes nor does it provide a description of structural features that are common to the genus. Since the disclosure fails to describe common attributes or characteristics that identify members of the genus, and because the genus is highly variant, the disclosure of Bax is insufficient to describe the genus. Thus, one of skill in the art would reasonably conclude that the disclosure fails to provide a representative number of species to describe and enable the genus as broadly claimed.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus, and therefore conception is not achieved until reduction to

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practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolation. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the bovine sequence.

Therefore, only an a mitochondrial apoptosis gene wherein said mitochondrial apoptosis gene is Bax, but not the full breadth of the claims, meets the written description provision of 35 U.S.C. 112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (see page 1115).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Macpherson et al (Proceedings of the American Association for Cancer Research Annual meeting, 3/02, 43: 407-408).

Claim 1 is drawn to a process for in vitro detection of resistance of cancer cells to oxaliplatin treatment characterized in that it involves the measurement of mitochondrial apoptosis of cancer cells that are treated or can or are to be treated with oxaliplatin. Claim 2 is drawn to the process according to claim 1, characterized in that the cancer is a colorectal cancer. Claim 3 is drawn to the process according to claims 1 or 2, characterized in that it involves the measurement of the expression of at least one mitochondrial apoptosis gene.

Macpherson et al teaches a process for in vitro detection of resistance of colorectal cancer cells to oxaliplatin treatment characterized in that it involves the measurement of mitochondrial apoptosis of cancer cells that are treated or can or are to be treated with oxaliplatin, further characterized in that it involves the measurement of the expression of Bax gene expression (see #2027 on pages 107-108, in particular).

Summary

No claim is allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E. Aeder, Ph.D. whose telephone number is 571-272-8787. The examiner can normally be reached on M-F: 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEA


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SUPERVISORY PATENT EXAMINER